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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/874,303	06/06/2001	Ron-Yen Shieh	MR933-544	7572

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EXAMINER

TREMBLAY, MARK STEPHEN

ART UNIT PAPER NUMBER

2827

DATE MAILED: 10/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/874,303

Applicant(s)

SHIEH ET AL

Examiner

Mark Tremblay

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Applicant: Shieh et al.

Filing date: 6/6/2001

***Specification***

35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear,  
5 concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are: "externally connection type" (throughout) "which is about 40 times of the USB1.0/1.1" (page 2, should read "which is about 40 times the speed of USB1.0/1.1") numerous instances of the article  
10 "the" in inappropriate ways or in places where antecedent basis has not been established in the spec (e.g. page 2, second line and fifth line), numerous instances of confused singular/plural usage (e.g. page 2, lines 1, 3, 6, 8). These are only examples, and there are numerous other instances of grammatically incorrect language which must be revised. Any response must include a substitute specification together with a marked up copy showing the changes made by Applicant. Failure to  
15 make a good faith effort to correct substantially all of the errors in the specification, including the title and abstract, will be treated as non-responsive by Examiner.

***Claim Objections***

Claims 3, 5 and 12 are objected to because of the following informalities: in claim 2 "a  
20 detachably USB 2.0 cable connection" is improper grammar; in claim 5, the last instance of "card" should be pluralized; in claim 12, the final word should be pluralized. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

25 Claims 1-12 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The phrase "externally connection type" is vague and indefinite. The phrase "insertion/connection" is indefinite, in that "/" is not defined. The phrase "various type" is both indefinite and grammatically improper, in context. The construction "allowing the insertion...

externally to the insertion cassette" is indefinite, since it suggests the a card being both inside and outside. Claim 2 is confusing to the point that the Examiner must rely primarily on the understanding of the invention gleaned from the drawings, rather than the words used in the claim, to understand the gist of the claim.

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***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

10

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

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Claims 1, 2 and 11 are rejected under 35 U.S.C. § 102(a) as being anticipated by the Atech Totalsolution Co. Udisk Launch slides, pages 1-51 ("Launch Slides" hereinafter). The Launch Slides appear to have been presented to over 600 guests at the official debut of the Udisk on Thursday, December 21, 2000 at the Taipei World Trade Center in Taiwan. The Launch Slides disclose an external connection type USB 2.0 interface flash card reader comprising an insertion cassette housing (see e.g. slide 18), and a USB 2.0 connection (see slide 19), characterized in that one end of the insertion cassette housing is provided with an insertion/connection hole allowing the insertion of various types (e.g. Udisk and mUdisk seen in slide 18) of solid state flash cards externally to the insertion cassette housing, and connecting to USB ports of a host computer (see e.g. slide 24) via the USB 2.0 interface.

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Re claim 2, it is inherently clear from the illustration that the usb connector is soldered directly to the PCB within the insertion cassette housing.

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***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the

manner in which the invention was made.

5 This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

10 Claims 1, 3-10, and 12 are rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent #6,438,638 to Jones et al. ("Jones" hereinafter) in view of Intel DeveloperUPDATEMagazine, "Which External I/O Bus is Right for You", 2000, pages 1-6 ("Intel" hereinafter). Jones discloses an external connection type USB interface flash card reader comprising an insertion cassette housing (see column 5, lines 34-44), and a USB connection cable  
15 (see e.g. fig 6), characterized in that one end of the insertion cassette housing is provided with an insertion/connection hole (column 5, line 41) allowing the insertion of various types of solid state flash cards (Compact flash, SmartMedia, Memory Stick, MMC, Secure Digital, and PCMCIA; see column 4, lines 45-56) externally to the insertion cassette housing, and connecting to USB ports of a host computer via the USB interface (figure 6). Jones does not disclose the version of USB  
20 used. Intel teaches that "USB 2.0 is fully backward and forward compatible with USB 1.1, so existing USB peripherals will continue to work in new USB 2.0 equipped PCS. This allows consumers to maintain their investment in peripherals, and continue to work with a familiar I/O port. Peripheral vendors can upgrade existing products to work with both USB 1.1 and 2.0 PCS, serving the emerging high-speed systems as well as the vast installed base. This will help to reduce  
25 development costs as well as inventory costs." See the text bridging pages 2-3. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use USB 2.0 in the Jones reader, because USB 2.0 is fully backward and forward compatible with earlier versions of USB, and USB 2.0 serves the emerging high-speed systems as well as the vast installed base, allowing makers of devices according to the Jones disclosure to reduce  
30 development and inventory costs.

Re claim 12, see column 4, lines 49-56).

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

UDIA homepage, <http://www.udisk.org>, last modified Monday, January 8, 2001.

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***Voice***

Inquiries for the Examiner should be directed to Mark Tremblay at (703) 305-5176. The Examiner's regular office hours are 10:30 am to 7:00 pm EST Monday to Friday. Voice mail is available. If Applicant has trouble contacting the Examiner, the Supervisory Patent Examiner, Michael Lee, can be reached on (703) 305-3503. Technical questions and comments concerning PTO procedures may be directed to the Patent Assistance Center hotline at 1-800-786-9199 or (703) 308-4357.

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***Fax Procedures***

Application papers may faxed to Art Unit 2876 at (703)872-9306. Faxes must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). Papers solely for the examiner's consideration, and not intended for immediate entry into the application (e.g., a proposed amendment) should be unsigned and clearly marked "Draft Copy" and faxed to (703) 746-5577.

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**MARK TREMBLAY**  
PRIMARY EXAMINER

September 24, 2003